

EXHIBIT 8

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re: Trademark Application of
Del Laboratories, Inc.
Serial No.: 75/778,612
Filing Dt.: August 19, 1999
For: N.Y.C. NEW YORK EYEWEAR
TM Atty.: Caroline E. Wood, Law Office 110

New York, New York
July 19, 2002

Box Responses
No Fee
Commissioner for Trademarks
2900 Crystal Drive
Arlington, VA 22202-3513

BRIEF ON APPEAL

Statement of the Case

This application was filed on August 19, 1999 to register the mark N.Y.C. NEW YORK EYEWEAR in a distinctive design for eyewear, namely, sunglasses, eyeglasses, frames, lenses, eyeglass cases and eyeglass cords in Class 9. As originally filed, the lining for the letter "C" was indicated as pink whereas magenta was intended. Accordingly, an Amendment Before First Action was filed and a statement added to the effect that the lining indicated the colors blue, orange and magenta and that color was claimed as a feature of the mark. A new drawing was submitted, and a copy is attached hereto as Exhibit A.

In an Office Action dated March 22, 2000 the application was rejected under Section 2(e)(2) on the ground that the mark is primarily geographically descriptive of the goods, the Examining Attorney stating that the primary significance of the mark is to indicate a geographic location which is neither obscure or remote so that the public is likely to believe that the geographical term identifies the place from which the goods originate. In response to the first Office Action, applicant disclaimed the letters "NYC" and the words "New York" apart from the mark as shown.

In a second Office Action the Examining Attorney maintained the rejection saying that the mark is shown only in capital colored letters which were not distinctive and that the word "eyewear" was itself highly descriptive. This rejection was made final. Applicant filed a further amendment and response in which it claimed ownership of Registration No. 2,418,035 dated January 2, 2001 for the mark N.Y.C. NEW YORK COLOR and again argued that because of the distinctiveness of the design, the mark was not primarily geographically descriptive but, rather, at most suggested that the goods embody a New York style which consumers would consider favorable and desirous. A copy of applicant's registration is attached as Exhibit B. The refusal to register was continued, and this appeal was taken.

Issue

Applicant's mark comprises the letters "N.Y.C." in a highly distinctive design and the words "New York" and "Eyewear", with "N.Y.C." and "New York" disclaimed. The issue in this case is whether said mark primarily indicates where the goods are made or sold or constitutes a distinctive trademark indicating source.

Argument

There is no question about the facts in this case. Applicant readily concedes that New York City is a famous city, that the letters "NYC" are an abbreviation for New York City and that the words "New York" are often used to mean not just New York City but New York State. Nevertheless, it is respectfully submitted that the mark as a whole clearly is not primarily geographically descriptive. It is thought that a consumer viewing a product bearing the mark would not immediately come to the conclusion that the product was made in New York City but would understand the mark as meaning a product from a particular source which partakes of the special ambience and/or fashion associated with New York City -- vivid and exciting. It is not possible to provide a specimen showing how the mark actually appears in the colors shown for which the drawing is lined because the mark has not yet been put into use. However, the mark shown in applicant's Registration No. 2,418,035 is and has been in use, and in order to indicate to the Board how applicant's mark actually appears with the colors indicated on the drawing and claimed, a specimen showing use of that mark is attached as Exhibit C. The sole purpose of this submission is to indicate the distinctiveness of the design embodied in the letters which, it is thought, is more easily demonstrated by the actual colors than by black and white lining.

It is desired to point out that there are many registrations including city names which have been granted without resort to Section 2(f) in various classes. It is recognized that the granting of such other registrations is not in any way binding upon the Examining Attorney and certainly is not binding on the Board. However, the existence of such registrations is thought to demonstrate that even without resort to Section 2(f), a mark including a city name but presented in a distinctive design can be considered to have as its primary significance indicating source rather than the geographical location where the goods might be made or sold.

The following are examples of the foregoing:

A. Registration No. 1,452,957 dated August 18, 1987 for the mark LUX DE PARIS in stylized form for optical instruments, namely, eyeglasses and spectacles. The word "Paris" has been disclaimed. The word "lux" is normally understood to mean "luxury". It would appear that the design was the basis for the registration.

B. Application No. 75/414,513 dated January 6, 1998 for the mark LONDON UNDERGROUND in a design for eyeglasses and sunglasses. This application was approved for publication with a disclaimer of the word "London". It is noted that the word "Underground" refers to the London subway system.

C. Registration No. 2,173,368 dated October 13, 1981 for the mark ROME 1001 in stylized letters for ladies sportswear issued with a disclaimer of the word "Rome", doubtless because of the distinctive nature of the mark as a whole.

D. In the case of Application No. 76/813,334 dated October 1, 1999, a mark comprising a design of a head, the letters "NYC" and the word "records" has been approved for publication in Classes 9 and 25 with a disclaimer of the words "NYC" and "records".

E. Registration No. 2,426,275 dated February 6, 2001 is for the mark HI-RISE RECORDS, NYC for a distinctive design and with a disclaimer of "records, NYC" as applied to a series of musical sound recordings.

F. Registration No. 2,126,970 dated January 6, 1998 is for the wordmark PARIS RECORDS for recording media, namely, phonograph records, pre-recorded audio cassettes and pre-recorded compact discs, etc. with the word "Records" disclaimed.

G. Registration No. 593,643 dated August 10, 1954 is for the word LONDON written in stylized letters as applied to phonograph records.

Printouts of the applications and registrations mentioned above are attached as Exhibit D.

The present application is one of a series of trademark applications filed by applicant, the predominant feature of which is the letters "N.Y.C." in the distinctive color design. It has already been mentioned that applicant owns Registration No. 2,418,035, so it should be added that applicant is the owner of application No. 75/866,877 dated December 8, 1999 for the mark N.Y.C. NEW YORK COLOR in Design as applied to eyewear, namely, sunglasses, eyeglasses, frames, lenses, eyeglass cases and eyeglass cords. A copy of the drawing from that application is attached as Exhibit E. It is noted that the words "NYC" and "New York" are disclaimed in said application. Said application was approved for publication and has received a Notice of Allowance.

It is noted that all of the applications and registrations referred to above are part of the records in the Patent and Trademark Office.

Conclusion

It is respectfully submitted that applicant's mark constituting a distinctive design comprising the words "N.Y.C." and "New York" and the word "Eyewear" is not primarily geographically descriptive but is distinctive and indicates a single source of the goods to be sold under the mark. It does not primarily connote or convey where the goods might be made or sold.

In view of the above, it is respectfully submitted that the refusal to register should be reversed and applicant's mark passed for publication.

Respectfully submitted,

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By 
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July 19, 2002

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Attention: Clerk

Re: Trademark: N.Y.C. NEW YORK COLOR
In Logo Form
Ser. No.: 75/778,612
Fil. Dt.: August 19, 1999
Applicant: Del Laboratories, Inc.

Dear Sir or Madam:

Enclosed herewith please find the original and two copies of applicant's Brief On Appeal in the above-entitled application. Please present the same to the Board for consideration.

Very truly yours,


DAVID B. KIRSCHSTEIN

DBK:dge
enclosure

cc: Caroline E. Wood,
Law Office 110

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TRADEMARK TRIAL AND
APPEAL BOARD